

Remarks

This Amendment is responsive to the Office Action mailed June 29, 2005.

At the outset, the Applicant is grateful for the allowance of claim 17, and for the indication of allowability of claim 7. Claim 5 has been amended to place claim 7 in independent form.

The amendments and remarks herein serve solely to more particularly point out and distinctly claim the subject matter of the present invention. The amendments are proper, do not add new matter, will not require additional searching and place all pending claims in condition for allowance.

Unresolved Issues/Errors

The Applicant's representative Mr. McCarthy and Mr. Davis discussed the rejection of claim 8 in view of the cited reference and reached agreement as to amending the claim in order to more particularly point out and distinctly claim the novel subject matter, as discussed below.

Also, the finality of the restriction requirement withdrawing group II claims 18-24 is erroneous because the Examiner's failure to construe claim 24 as a valid linking claim is without basis in the law. Nevertheless, and solely in order to facilitate furthering prosecution on the merits, the Applicant has canceled the group II claims without prejudice.

Summary of Telephone Interview

The Applicant appreciates Mr. Davis participating in the telephone interview with Mr. McCarthy on August 16, 2005. The Applicant traversed the final rejection of claim 8

and the final withdrawal of claim 24; agreement was reached only in resolving the claim 8 issue.

As for claim 8, agreement was reached that Walsh '291 discloses a circulation path from the relatively higher pressure area at inlet 21 to the relatively lower pressure area at outlet 32. Agreement was also reached that the claim term "impinging" means the redirected portion physically strikes the outer edge of the disc. Agreement was also reached that in the disclosed embodiments of Walsh '291 the redirected portion passes by the outer edge of the disc while flowing inside the tube 31, and thus does not impinge the outer edge. Some discussion was directed by Mr. Davis as to whether under different operating conditions (such as spinning the discs backwards) the construction of Walsh '291 could reasonably anticipate the claim; no agreement was reached. A mutually acceptable solution was reached to amend the language to more explicitly recite that the present embodiments contemplate both the inlet and outlet of the redirected portion being beyond the outer diameter of the disc. The amendment to claim 8 reflects that agreement.

As for claim 24, Applicant urged the "steps-for" claim is encompassed by MPEP 809.03(C) because it is a "means" clause under 35 USC 112 para. 6; no agreement was reached. The Examiner urged the Applicant to consider redrafting the claim as a "product" under MPEP 809.03(B) as opposed to an "apparatus"; again, no agreement was reached.

Restriction Requirement

The Examiner's failure to construe claim 24 as a linking claim, as explicitly provided in MPEP 809.03(C), is erroneous and reversible as a matter of law.

The Examiner is obliged to construe claim 24 in accordance with 35 USC 112 para. 6, such that the "steps for redirecting" read on the acts described for attenuating flow-induced disturbances, and their equivalents. *In re Donaldson Co. Inc.*, 29 USPQ2d 1845 (Fed. Cir. 1994)(*en banc*); *Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. Para. 6*, 65 FR 38510. Such a proper construction reaches the conclusion that the "steps for redirecting" element encompasses the process steps recited in the independent claims of the group I process claims. Accordingly, claim 24 links the process and apparatus claims.

Linking claims must be examined with the invention elected, and should any linking claim be allowed, the restriction requirement must be withdrawn. (MPEP 809)

Applicant's previous arguments that claim 24 is a linking claim were dismissed on the basis that the group I claims and claim 24 do not explicitly recite the same language. For example, the Examiner asserted the following: "Claims 5-11 and 16-17 require a surface to be mechanically isolated from the actuator arm, however, claims 18-28 do not require a surface to be mechanically isolated." This assertion by the Examiner is false.

The present embodiments as claimed in claim 24 divert a portion of an airflow via the surface to redirect the rest of the airflow that otherwise would impinge squarely against the actuator. The function associated with the claimed subject matter diverts the portion of the airflow in order to attenuate disturbances. If the surface is not mechanically isolated, then the forces associated with diverting the airflow will act directly on the actuator, defeating the very purpose of the claimed subject matter.

Therefore, a proper construction of claim 24 concludes that the "steps-for" element encompasses the act of mechanically isolating the surface from the actuator arm. Contrary to

the Examiner's criticism of claim 24 language, it is an explicit requirement of Section 112 para. 6 that acts not be recited.

Accordingly, the Examiner's failure to construe claim 24 as a linking claim is reversible error. Nevertheless, and solely in order to facilitate prosecution on the merits, the Applicant has canceled the group II claims without prejudice.

Rejection of Claims Under 35 U.S.C. §103(b)

Claims 5, 6, 8, 10, 11, and 16 were rejected as being unpatentable over Schneider '889 in view of Walsh '291.

Claim 5

The Applicant gratefully acknowledges the indication of allowable subject matter in claim 7. Claim 5 has been amended herein in order to place claim 7 in independent form, thereby obviating the objection to claim 7. Reconsideration and withdrawal of the present rejection of claim 5 and the claims depending therefrom are respectfully requested.

Claim 8

Claim 8 recites at least the following features:

A method...comprising...impinging the redirected portion on an outer edge of the disc in a direction toward an inner diameter of the disc.
(excerpt of claim 8, emphasis added)

The Examiner's basis for the final rejection of claim 8 is as follows: "Figure 1 shows redirecting a portion of a tangential gas flow generated by a rotation of a first disc 11 of the disc drive along a surface impinging the redirected portion on an outer edge of the first disc

in a direction toward an inner diameter.” (Office Action of 6-29-2005, pg. 4, emphasis added) This statement is false.

The ordinary meaning of the claim term “impinge” means to strike or to collide. That is, impingement of one body against another requires contact of the two bodies. The disclosure of Walsh ‘291 is wholly silent regarding the redirected airflow impinging an outer edge of the disc; rather, Walsh ‘291 explicitly prevents the redirected airflow from impinging the outer edge of the disc in order to deliver it to the central part of the disc. See, for example:

The outlet of the filter is then discharged in the relatively lower pressure near the hub of the disk so that a continuous self-purging flow is established as the disk rotates...The teachings of these aforementioned copending patent applications are hereby incorporated by reference for full force and effect as if set forth in full herein.
(Walsh ‘291, col. 2 lines 14-26, emphasis added)

means for extracting a portion of gas from the housing near the periphery of the rotatable member and for returning the portion of gas to the housing at a lower pressure region.
(Walsh ‘291, col. 2 lines 36-37, emphasis added)

the flat end face 33 is spaced about 1/16 to 1/8 inch from the face of the disk near its center where the pressure due to the pumping action of the disk is lowest.
(Walsh ‘291, col. 4 lines 34-37, emphasis added)

The disk rotating in the housing is, in effect, a very low efficiency centrifugal blower with air entering near the center and leaving near the periphery. In the self purging system this gas stream is recirculated from the exit to the return point through a filter.
(Walsh ‘291, col. 4 lines 57-62, emphasis added)

In Walsh ‘291, FIGS. 1 and 5, along with the corresponding discussions thereof, clearly disclose that the redirected airflow is prevented from impinging on the outer edge of

the rotating discs. In FIG. 1, for example, the end fitting 32 is installed near the disc center. The redirected airflow is prevented from impinging on the outer edge of the disc because it flows past the outer edge while still within the conduit 31. Similarly, in other embodiments the deflector 64, through which the redirected airflow re-enters the enclosure, is located near the disc center. In these embodiments, however, the redirected airflow conduit is not located inside the enclosure near the edge of the discs, and hence the redirected airflow cannot in any manner impinge the outer edge of the disc.

Nevertheless, the Applicant's representative and the Examiner agreed in the telephone interview that the novelty requirement over Walsh '291 is satisfied by amending claim 8, as done herein, to more particularly point out and distinctly claim that both ends of the redirected flow are beyond the outer diameter of the disc. Accordingly, the Applicant has amended the claim language from *redirecting a portion of a tangential gas flow* to *redirecting a portion of a gas flow from beyond an outer diameter of a disc*.

The Applicant further points out that there is absolutely no disclosure from Walsh '291 or any other reference of record that would motivate a skilled artisan to modify and/or combine the references to arrive at the present embodiments as claimed in claim 8. Walsh '291 does contemplate alternative embodiments wherein a deflector (FIG. 3) is used at the end of the tube 31 to draw fluid from the tube 31 in relation to the velocity of the fluid rushing past the tube. However, Walsh '291 only contemplates the return end of the tube 31 being adjacent the disc where the disc creates the fluid velocity. Walsh '291 is wholly silent regarding returning the fluid flow beyond the disc periphery, and therefore does not disclose or suggest impinging the return fluid on the disc edge.

Accordingly, Walsh '291 cannot sustain either a Section 102 or a Section 103

rejection of amended claim 8 because it does not disclose or suggest all the features of the present embodiments as claimed. Withdrawal of the final rejection and reconsideration of claim 8 and the claims depending therefrom are respectfully requested.

Allowable Subject Matter

The Applicant gratefully acknowledges the indication of allowable subject matter of claim 9. However, the Applicant has opted not to place claim 9 in independent form at this time because the broader independent claim from which it depends is allowable, for reasons discussed above.

Conclusion

This is a complete response to the Office Action mailed June 29, 2005. The Applicant respectfully requests that the Examiner enter the above amendments, reconsider the application and allow all of the pending claims. The Applicant has submitted herewith a Request for Telephone Interview with the Examiner, to be conducted after such time that the Examiner has had the opportunity to fully consider this Amendment, and before the next action on the merits, if it is determined that all pending claims are not in condition for allowance. The interview would be necessary to clarify any issues preventing passage to allowance where agreement on allowability was previously reached.

The Examiner is invited to contact the below signed Attorney should any questions arise concerning this response or request for interview.

Respectfully submitted,

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